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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/705,461

11/10/2003

Shinichi Shinohara

SHX 318A

5739

23581

7590

09/16/2005

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EXAMINER

HARAN, JOHN T

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/705,461

Applicant(s)

SHINOHARA ET AL.

Examiner

John T. Haran

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1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/778,232.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/11/05, 3/8/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> .           |

Continuation of Attachment(s) 6). Other: translation of priority document.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 3/8/04 and 8/11/05 have been considered by the examiner.
2. It is noted that in the IDS filed on 8/11/05 the Korean Office Action fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

3. The disclosure is objected to because of the following informalities: the related applications section should be amended to indicate that application 09/778,232 is now U.S. Patent 6,685,794.

Appropriate correction is required.

### ***Priority***

4. It is noted that a certified translation of the priority papers was filed in the parent application, thereby perfecting the priority date of 4/27/00. A copy of the translation filed in the parent application is attached.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by Naka et al (U.S. Patent 5,935,331).

The claim language of claim 1 only requires a nozzle capable of dispensing adhesive, an electrode means, and an electric power supply for generating an electric field between the nozzle and the electrode means. The material worked upon (optical disc substrates, adhesive) is not considered part of the apparatus.

Naka et al is directed to an apparatus that comprises a nozzle (130) capable of dispensing adhesive, an electrode means (132) and an electric power supply (134) for generating an electric field between the electrode means and the nozzle (See Figure 11; Column 14, lines 22-36). Naka et al anticipates claim 1.

Regarding claim 10, the effects of the electric field is functional language, which is given little weight. The electric field generated in apparatus of Naka et al would have

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the claimed effect on the liquid dispensed from the nozzle. Naka et al anticipates claim 10.

7. Claims 11 and 12 rejected under 35 U.S.C. 102(e) as being anticipated by Yamaguchi et al (U.S. Patent 6,494,987).

The applied reference has a common inventors and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 11 and 12, the claim language only requires a device for forming an electric field between two objects. The material worked upon (optical disc substrates, adhesive) is not considered part of the apparatus. Also the effects of the electric field on the liquid film of adhesive is functional language, which is given little weight.

Yamaguchi et al discloses an optical disc bonding apparatus that creates an electric field between two optical discs, which have the desired tapering effects on the adhesive (See Figures 9A-9C and 14). Yamaguchi et al anticipates claims 11 and 12.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naka et al (U.S. Patent 5,935,331), as applied above to claim 1.

As noted above, Naka et al discloses an apparatus that comprises a nozzle (130) capable of dispensing adhesive, an electrode means (132) and an electric power supply (134) for generating an electric field between the electrode means and the nozzle (See Figure 11; Column 14, lines 22-36).

Regarding claims 2 and 3, Naka et al teaches there can be a plurality of nozzles (See Figure 22). One skilled in the art would have readily appreciated that the arrangement of the nozzles would depend upon the material worked upon and the desired pattern for the dispensed liquid on the substrate. The claimed nozzle arrangements are conventional in the art and it would have been within the mechanical skill of one of ordinary skill in the art to incorporate such an arrangement of nozzles in the apparatus of Naka et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the claimed arrangement of nozzles in the apparatus of Naka et al.

Regarding claims 4-9, Naka et al is silent towards whether the electric power supply generates an alternating current or a direct current, however one skilled in the art

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would have readily appreciated both are known and obvious alternate expedients over one another and it would have been obvious to use either in the apparatus of Naka et al.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 24 of U.S. Patent No. 6,494,987. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 24 of the patent encompasses claims 11 and 12 of the present application.

12. Claims 11 and 12 directed to an invention not patentably distinct from claim 24 of commonly assigned U.S. Patent 6,494,987, as discussed above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP



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§ 2302). Commonly assigned U.S. Patent 6,494,987, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.


### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John T. Haran whose telephone number is (571) 272-1217. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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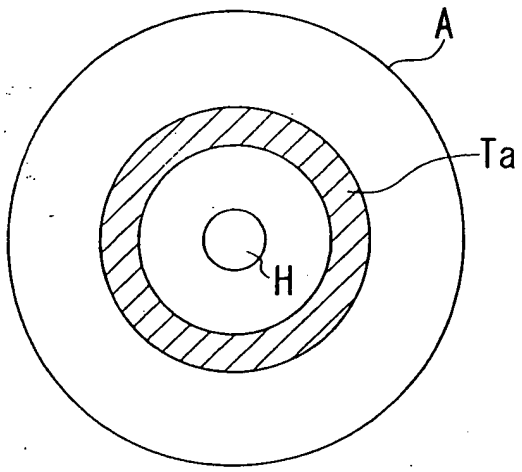
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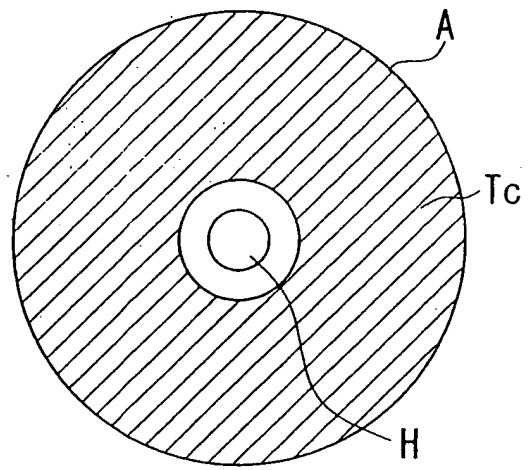
John T. Haran  
Primary Examiner  
Art Unit 1733

Fig. 1

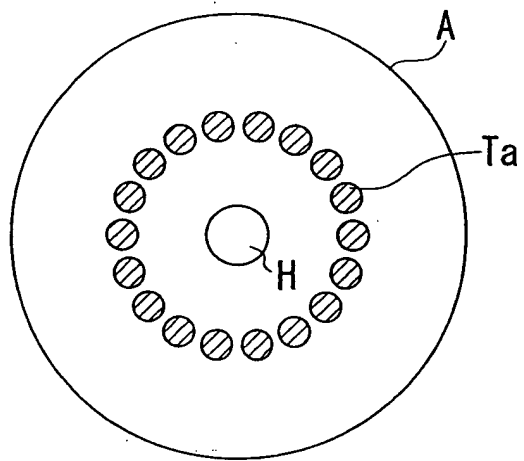
(A)



(C)



(B)



(D)

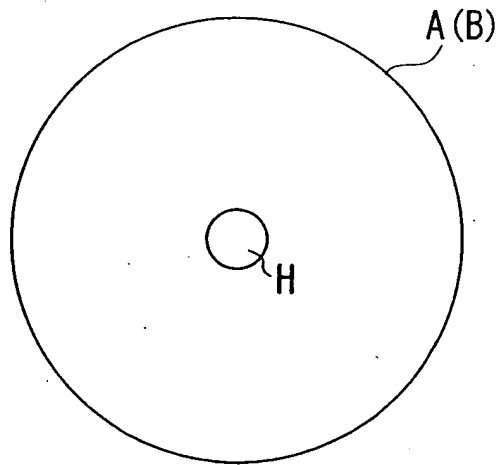


Fig. 2

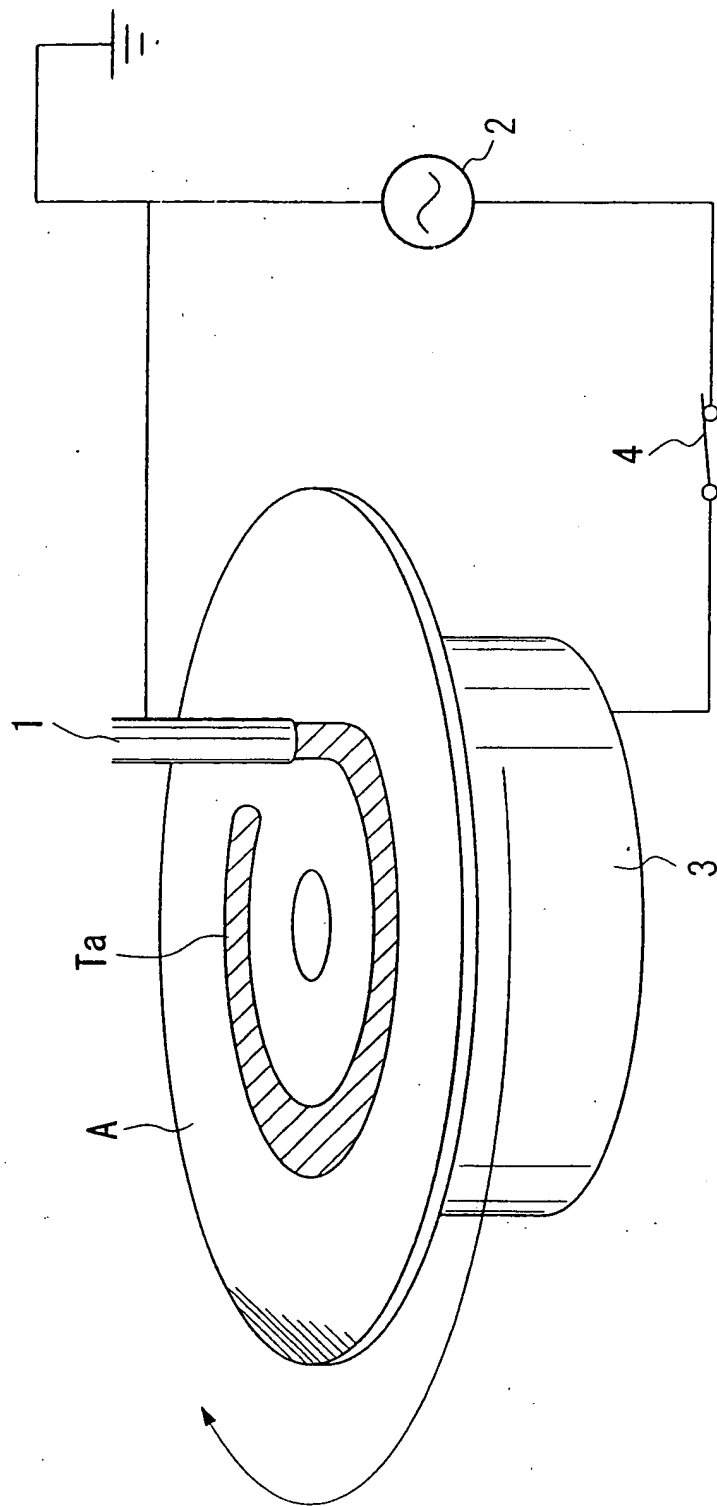


Fig. 3

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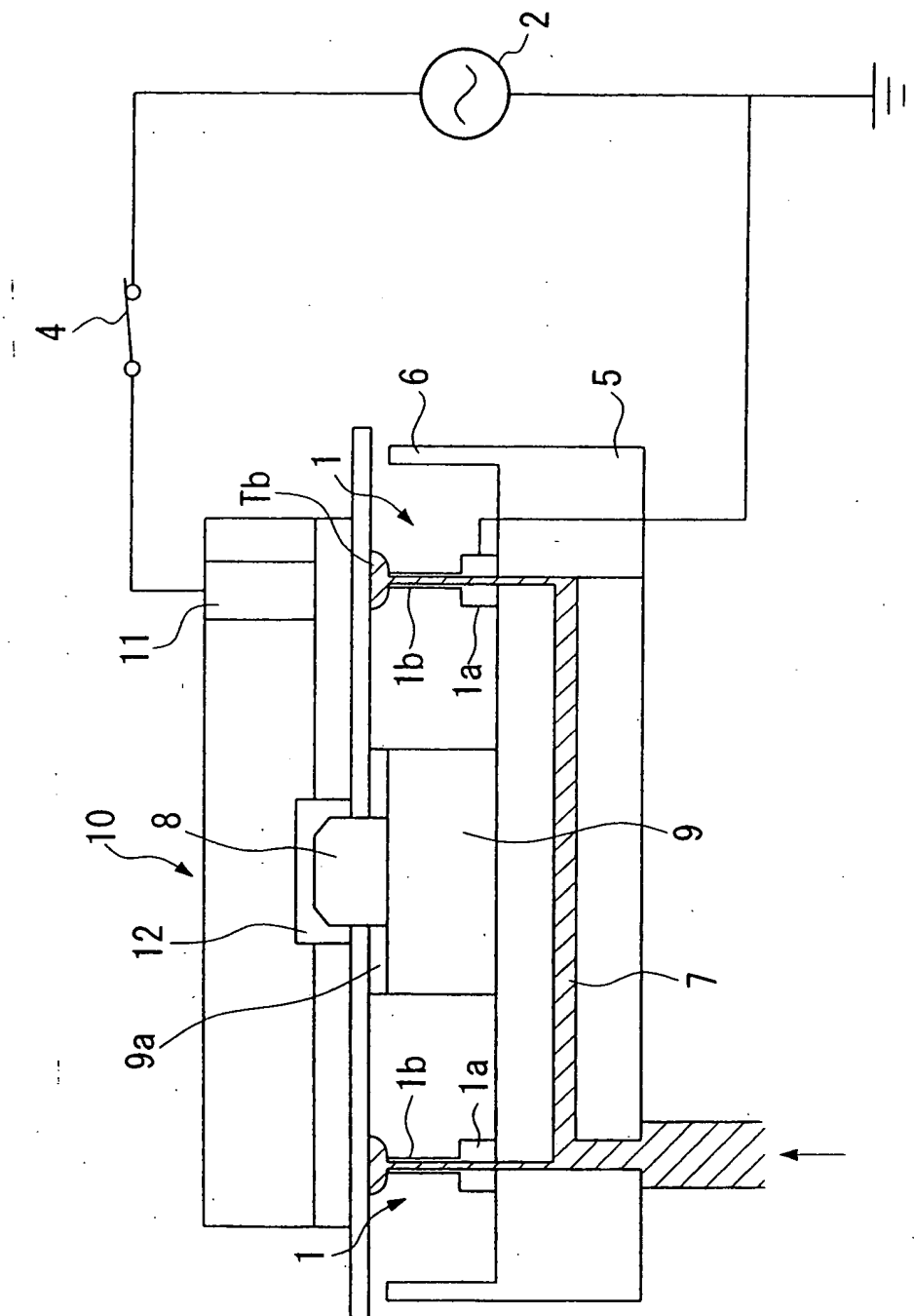


Fig. 4

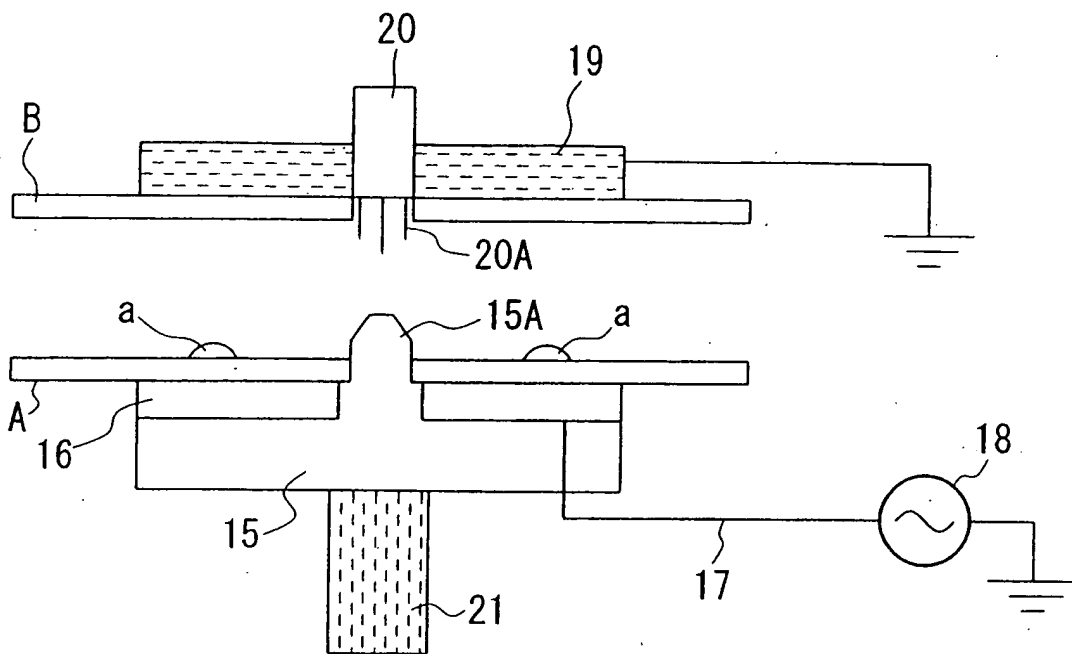


Fig. 5

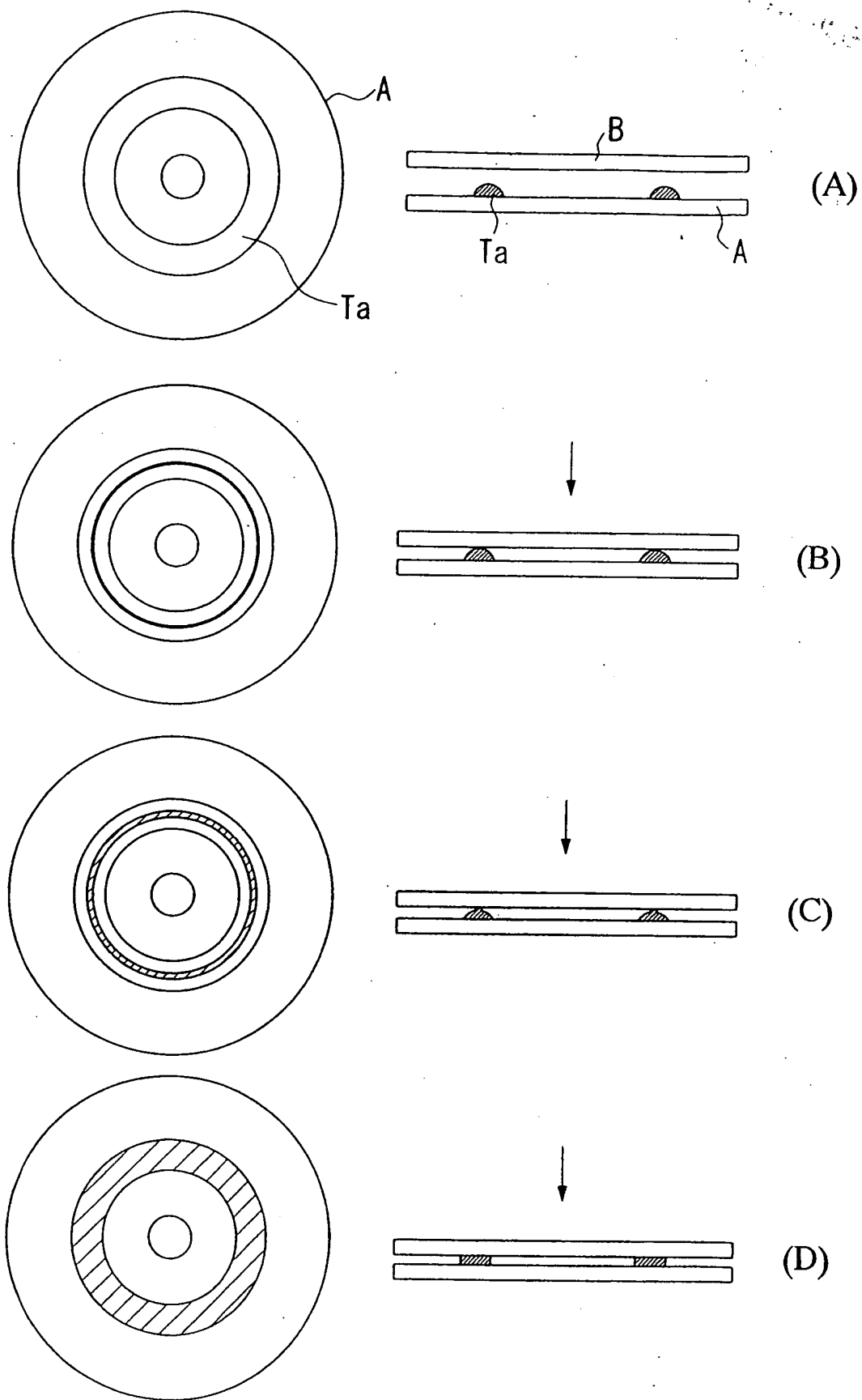




Fig. 6

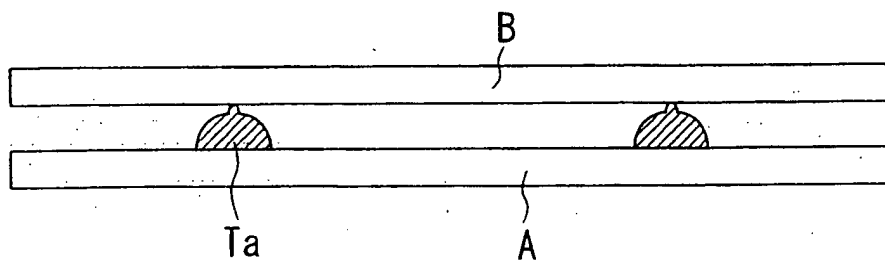
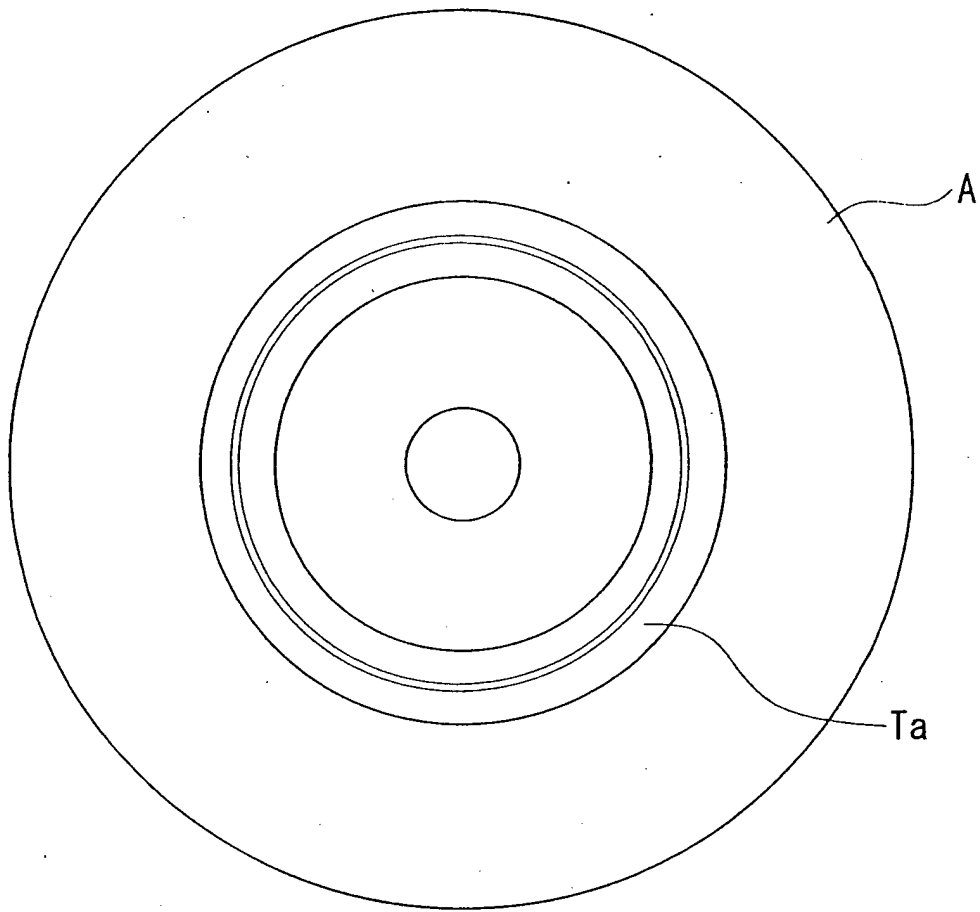






Fig. 7

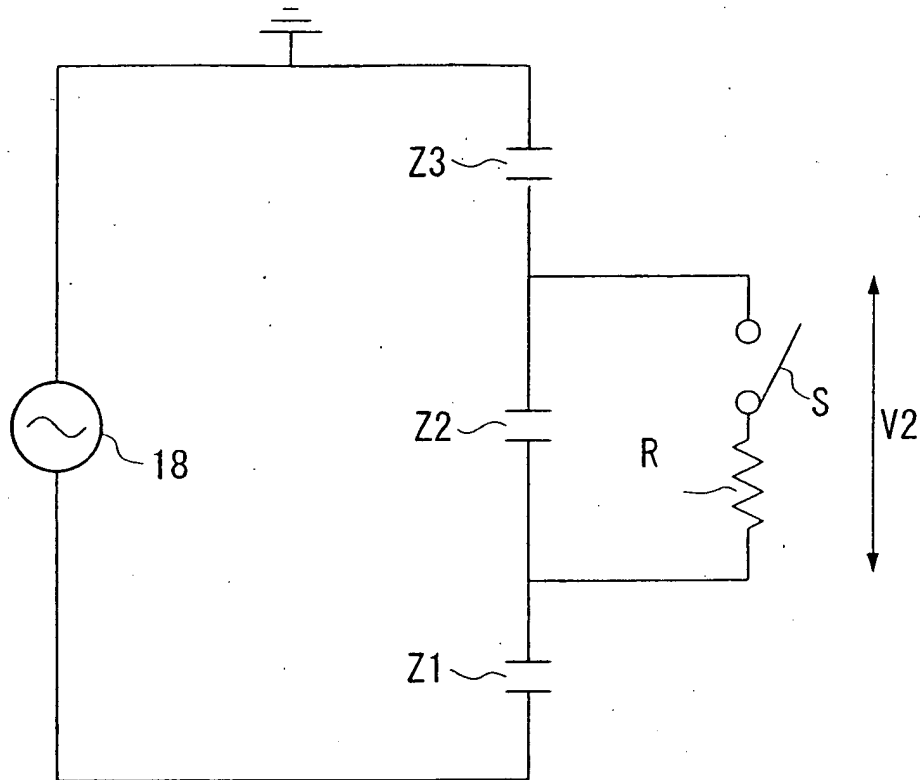




Fig. 8

